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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/602,987
Filing Date: June 25, 2003
Appellant(s): WASILEWSKI ET AL.

David Rodack
Reg. No. 47,034
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 3 August 2009 appealing from the Office action
mailed 2 April 2009

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The co-pending applications **10/602,986** and **10/602,988** are the related appeals, interferences, or judicial proceedings which may affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

Candelore et al. (U.S. Patent 7,376,233) – *with incorporated by reference* of Unger et al. (U.S. Patent 2003/0026423).

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1 – 19 are rejected under 35 U.S.C. 102(e) as being anticipated by Candelore et al. (U.S. Patent 7,376,233) – *with incorporated by reference* of Unger et al. (U.S. Patent 2003/0026423).

As per claim **1 and 13**, Candelore teaches a method for providing a plurality of programs in a conditional access system, the method comprising the steps of:

using a packet identifier to select for encryption a portion of each of a plurality of digital bit streams from a transport stream (Candelore: Column 15 Line 34 – 52, Column 3 Line 51 – 62, Column 6 Line 16 – 22 and Column 4 Line 3 – 16: PID is used by the selective encryption encoder to determine which packets are to be encrypted according a specific encryption method);

encrypting the selected portion of each of the plurality of digital bit stream (Candelore: Column 15 Line 34 – 52, Column 4 Line 3 – 16: PID is used by the selective encryption encoder to determine which packets are to be encrypted according a specific encryption method);

combining the encrypted portion and the unencrypted portion with the transport stream (Candelore: Column 15 Line 34 – 52 and Column 6 Line 16 – 51); and

transmitting the combined stream (Candelore: Figure 1).

As per claim 2 and 14, Candelore / *Unger (incorporated by reference)* teaches each of the plurality of digital bit streams includes a packet identifier, and wherein using a packet identifier to select for encryption a portion of each of the plurality of digital bit streams by identifying a predetermined packet identifier (Candelore: Column 3 Line 51 – 62, Column 6 Line 16 – 22 and Column 4 Line 3 – 16) || (Unger: Para [0010] Line 1 – 7, Para [0037] Line 1 – 3).

As per claim 3 and 15, Candelore / *Unger (incorporated by reference)* teaches each of the plurality of digital bit streams includes a packet identifier, and wherein using a packet identifier to select for encryption selects the plurality of digital bit streams by identifying a plurality of predetermined packet identifiers (Candelore: Column 3 Line 51 – 62, Column 6 Line 16 – 22 and Column 4 Line 3 – 16) || (Unger: Para [0010] Line 1 – 7, Para [0037] Line 1 – 3).

As per claim 4, Candelore / *Unger (incorporated by reference)* teaches the selected plurality of digital bit streams are programs (Candelore: Column 3 Line 61 – 63, Column 6 Line 36 – 37 and Column 4 Line 17 – 19) || (Unger: Table 1 and Para [0055]).

As per claim 5, Candelore / *Unger (incorporated by reference)* teaches the selected plurality of digital bit streams are elementary digital bit streams (Candelore: Column 3 Line 61 – 62) || (Unger: Table 1, Para [0087], [0109] and [0010]).

As per claim 6, Candelore / *Unger (incorporated by reference)* teaches a portion of the selected plurality of digital bit streams is encrypted according to the packet identifier associated with each of the plurality of digital bit streams (Candelore: Column 3 Line 51 – 62, Column 6

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Line 16 – 22 and Column 4 Line 3 – 16) || (Unger: Para [0010] Line 1 – 7, Para [0037] Line 1 – 3).

As per claim 7, Candelore / *Unger (incorporated by reference)* teaches the packet identifier is indicative of each of the plurality of digital bit streams being one of a video stream, an audio stream, and a data stream (Candelore: Column 3 Line 51 – 62, Column 6 Line 16 – 22 and Column 4 Line 3 – 16) || (Unger: Para [0010] Line 1 – 7, Para [0037] Line 1 – 3).

As per claim 8 and 16, Candelore / *Unger (incorporated by reference)* teaches the encrypted portion includes at least one of the plurality of digital bit streams associated with the video stream (Candelore: Column 3 Line 51 – 62).

As per claim 9 and 17, Candelore / *Unger (incorporated by reference)* teaches the encrypted portion includes at least one of the plurality of digital bit streams associated with the audio stream (Candelore: Column 3 Line 51 – 62).

As per claim 10 and 18, Candelore / *Unger (incorporated by reference)* teaches the encrypted portion includes at least one of the plurality of digital bit streams associated with the data stream (Candelore: Column 3 Line 51 – 62).

As per claim 11 and 19, Candelore / *Unger (incorporated by reference)* teaches the encrypted portion includes at least one of the plurality of digital bit streams associated with at least one of the video stream, the audio stream, and the data stream (Candelore: Column 3 Line 51 – 62).

As per claim 12, Candalore / Unger (*incorporated by reference*) teaches the portion of the plurality of digital bit streams is encrypted according to a first level encryption method (Candalore: Column 6 Line 44 and Column 8 Line 24 – 25) || (Unger: Table 1 and Figure 6 / E318 & Para [0054], [0072] and [0073]).

(10) Response to Argument

In the instant appeal brief, Appellant has the presented the following arguments:

Appellants disagree the denial of the beneficial priority date.

Examiner notes that the applicability of the prior-art listed in Section (9) Grounds of Rejection is not challenged and the only assertion by Appellants is that Candalore does not qualify as prior art since the claims of the instant application benefit to an earlier priority date.

The instant claims are not rejected under 112, first paragraph as they were original to the application as filed on 25 June 2003. However, to obtain benefit of the priority date of a parent CON case or a prior provisional application, support for the claimed subject matter must be provided within those applications themselves. Appellants do not make that showing, and merely allege that having the instant application state that it is a CON is sufficient to confer the benefit of the prior date.

Appellant alleged: "Appellants disagree the denial of the beneficial priority date. In addition, since the current application is a continuation along a line of continuations having an effective priority date of July 8, 1998, the effective filing date at least goes back to July 8, 1998 or even can be dated back to the provisional application date of August 1, 1997". *Examiner respectfully disagrees.*

Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119(e) and 35 U.S.C. 120 as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, Application No. 09/111,958 filed on 8 July 1998 or any of Provisional applications filed 1 August 1997 (*as alleged by Appellant*), fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application such as **"using a packet identifier to select for encryption a portion of each of a plurality of digital bit streams from a transport stream"** and **"combining the encrypted portion and unencrypted portion with the transport stream"** as recited in the base claims.

The arguments presented in the Appeal brief filed 3 August 2009 are responded as follows. Examiner notes the disclosure of the prior-filed application, for example, the immediate parent CON Application No. 09/930,901 filed on 16 August 2001, now US Pat No. 6,937,729 issued 30 August 2005 fails to provide adequate support in the manner required by the first paragraph of 35 U.S.C. 112 for one or more claims of this application such as **" using a packet identifier to select for encryption a portion of each of a plurality of digital bit streams**

from a transport stream" and "combining the encrypted portion and unencrypted portion with the transport stream" as recited in claim 1.

- The parent CON application now US PAT No. 6,937,729 at column 18, lines 44-59, where the phrase "Any part or all.." is recited at column 18, lines 54-55, fails to disclose the concept of "partial encryption" of the video bitstream as now claimed in the instant application.
- Appellant asserts the disclosures of (a) "any part or all of MPEG transport stream may be encrypted (*Brief: Page 5 Line 10 – 12*)" (also as per Provisional 60/054,575, Page 28, Line 25 – 26) and (b) "Figure 3 and the above-noted specification portion reveals a digital bit stream (e.g., transport stream) comprising ECM encrypted according to 3DES (e.g., 321) and audio/video/data content coded according to DES (e.g., 327) (*Brief: Page 5 Line 4 – 6*)" (also as per Provisional 60/054,575, Figure 3). Examiner respectfully disagrees because:
 - Examiner notes, considering "any part or all of MPEG transport stream may be encrypted" (also as per Provisional 60/054,575, Page 28, Line 25 – 26) and "the standard provides for a transport stream (MPEG) that includes a number of component streams and some of these carry content (i.e. video, audio or data), another carries the ECM, and a third carries the EMM and only the streams carrying content are encrypted according to DES; since the control word in ECM and the contents of EMM have already been encrypted, no further encryption is needed

when they are sent in the MPEG-2 transport stream" (also as per **Provisional 60/054,575, Page 13, Line 9 – 14 and Figure 3 & 7**), this disclosure reveals ECM message as one part of the component of MPEG transport stream *has no further encryption needed*; however, the ECM bit stream itself is indeed encrypted with 3DES technique (i.e. a content key (control word CW) carried by ECM is encrypted by 3DES as a key-encryption-key protection technique) and audio/video/data content bit stream is encrypted according to DES technique and as such the disclosure has no support as to claim limitation indicating a portion of a single bit stream from a plurality of bit streams is selected for encryption *by using packet identifier* and further combined with *unencrypted* portion of bit stream to constitute a equivalent partially-encrypted bit stream, which is recited as "*using a packet identifier to select for encryption a portion of each of a plurality of digital bit streams from a transport stream*" and "*combining the encrypted portion and the unencrypted portion with the transport stream*" and as such Applicant's arguments are respectfully traversed.

- Page 13, lines 1-5 of the instant application describes the content stream 329 as one component bit stream and is the only one encrypted according to DES 329. But there is no disclosure here of "a part" of this content bitstream being encrypted, or as in claim 1, "select for encryption a portion of each of a plurality of digital bit streams".
- The single phrase "Any part or all of MPEG transport stream may be encrypted" in the parent CON application and/or the provisional application is a description of the well known (at the time of filing the parent CON and prior provisional application) MPEG2 standard where the video (content) bit stream may be encrypted in its entirety.

As disclosed in Figure 7 of provisional 60/054,575 where the TRANSPORT STREAM 701 is the entirety of the bitstreams being multiplexed. The disclosure of "Any part or all..." solely discloses that any component bitstream (or subcategory stream) of MPEG2 transport stream such as the video (content) bit stream (as a component or subcategory bitstream of the whole transport program stream 701, Figure 7) may be encrypted or not.

However, the single phrase "any part or all" does not provide one skilled in the art with the understanding that Appellant as of the filing date of the parent CON Application No. 09/930,901 filed on 16 August 2001, now US Pat No. 6,937,729 issued 30 August 2005 and/or provisional application 60/054,575 filed 01 August 1997) had in his possession the invention of partial encryption as described in Candelore, i.e. encryption of only a portion of a video (content) bitstream (or subcategory stream) within a MPEG2 transport stream. Therefore, there is no support of claim limitation (with earlier priority date) such as "using a packet identifier to select for encryption a portion of each of a plurality of digital bit streams from a transport stream; encrypting a portion of each of the plurality of digital bit streams", as recited in the instant claims.

Therefore, the beneficial priority date has been denied since the parent CON application and/or prior provisional application do not support what is being claimed in the instant application.

11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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